## REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following remarks.

### I. Status of the Claims

Claims 12, 54 and 88 are currently amended to delete or replace trademarks with the corresponding generic names of the compounds. Support for the amendment to claims 12, 54 and 88 can be found, inter alia, in paragraph 0112 of the specification.

As the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested. Upon entry of the foregoing amendment, claims 1-107 will be pending in the application, with 1, 39, 65 and 93 being the independent claims.

### II. The Objection to the Specification

The Examiner objected to the specification for containing impermissible embedded browser-executable code without specifying the location of the alleged hyperlinks. Replacement paragraphs 0010, 0013, 0162, 0163 and 0168 are provided herein to delete such hyperlinks. Accordingly, the objection is now moot.

### III. The Objection to the Claims

The Examiner objected to claims 18, 57 and 85 for containing trademarks. Claims 18, 57 and 85 have been amended to delete or replace trademarks with the corresponding generic names of the compounds. Accordingly, the objection is now moot.

## IV. The Rejection Under 35 U.S.C. § 112, 2nd Paragraph

The Examiner rejected claims 39-64 under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, the Examiner requires clarification of the term "a time and under conditions" in the claims. Applicants respectfully traverse this rejection.

The language of independent claim 39 and dependent claims 40-64 is definite because "those skilled in the art would understand what is claimed when the claim is read in light of the specification." (See MPEP 2173.02).

Claim 39 as a whole reads:

> A method of making a nanoparticulate topiramate composition comprising contacting topiramate particles with at least one surface stabilizer for a time and under conditions sufficient to provide a nanoparticulate topiramate composition having an effective average particle size of less than about 2 microns.

The claim relates to a method of producing a nanoparticulate topiramate composition, where the resultant particles have an effective average particle size of less than about 2 microns. The method includes the step of contacting components "for a time and under conditions sufficient" to yield particles with an average effective size of 2 microns. The specification provides a variety of non-limiting, exemplary methods of making such topiramate compositions, and also provides a variety of non-limiting times and conditions under which such particles may be formed, depending on the method chosen. *See, e.g.*, non-limiting Examples 1-3 on pages 52-56 of the specification.

For each of the different exemplary methods provided, the "time and conditions" may vary. First, one skilled in the art would be well acquainted with the fact that variations in time (e.g., mill time, homogenization time, precipitation time, etc.) and conditions (e.g., milling conditions, chamber size or volume, batch size, temperature, attrition media, etc.) are required to generate nanoparticles of a particular size by any given method. Indeed, one may have to adjust the time and conditions, for example, as per a mill manufacturer's instructions. Second, one skilled in the art would understand that "time and conditions" sufficient to yield particles with an average effective size of about 2 microns may vary depending on the

amount, quality or even brand of surface stabilizer used. Thus, it is understood that some empirical study may be required to optimize "time and conditions" for any given method or system to yield particles of the desired effective average size.

Accordingly, one skilled in the art would understand what is claimed when the claim is read in light of the specification; specifically, one skilled in the art could clearly ascertain the meaning of "for a time and under conditions sufficient to provide a topiramate composition having an average effective particle size of less than 2 microns." As such, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

## V. The Provisional Nonstatutory Obviousness-Type Double Patenting Rejection

*(a) U.S. Patent No. 6, 592,903 in view of U.S. Patent No. 6,696,091*

The Examiner rejected claims 1, 2, 4, 6-8, 10 and 11 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 2, 5-7, 9-14 and 18-20 of U.S. Pat. No. 6,592,903 for "Solid Dose Nanoparticulate Compositions Comprising a Synergistic Combination of a Polymeric Surface Stabilizer and Dioctyl Sodium Sulfosuccinate" ("the '903 patent") in view of U.S. Pat. No. 6,696,091 for "Pharmaceutical Composition of Topiramate" ("the '091 patent"). Applicants respectfully traverse this ground for rejection.

The '903 patent is directed to the use of a combination of a polymeric surface stabilizer and dioctyl sodium sulfosuccinate (DOSS) in preparing a solid dosage form of a nanoparticulate active agent to aide in redispersion of the active agent from the solid dosage form following administration. The '903 patent does not teach or suggest the use of topiramate in nanoparticulate dosage forms, as required by the claimed invention.

The '091 patent refers to conventional, non-nanoparticulate formulations of topiramate. Thus, the topiramate formulations of this patent suffer from the prior art topiramate dosage form problems identified in the specification. *See e.g.,* paragraph [0025] ("There is a need in the art for topiramate formulations which can decrease frequency of

dosing, improve clinical efficacy, and potentially reduce side effects. The present invention satisfies these needs.") The '091 patent does not teach or suggest the use of topiramate in nanoparticulate dosage forms, as required by the claimed invention.

It appears that the Examiner is alleging that the '903 patent teaches nanoparticulate active agent compositions, including "anti-epileptics" as active agents, and the '091 patent teaches that topiramate is an active agent, so it allegedly would be obvious to combine the two to obtain the claimed invention. Applicants respectfully disagree with the Examiner's analysis and conclusion.

### 1. Lack of Motivation to Combine the Cited References

The Examiner's alleged "motivation to combine" hinges on the fact that the '091 patent teaches that the class of compounds "anti-epileptics" can be used in nanoparticulate active agent compositions, and the '091 patent teaches that topiramate is an anti-epileptic. However, this rational fails to note that "anti-epileptics" (also known as anticonvulsants) encompasses a large number of different classes of drugs, as well as specific examples of drugs within each class, as shown in the table below.

| Class of anti-epileptic compound | Examples |
|---|---|
| aldehydes | Paraldehyde |
| aromatic allylic alcohols | Stiripentol |
| barbituates | Phenobarbital<br>Methylphenobarbital<br>Metharbital<br>barbexaclone |
| benzodiazepines | Clobazam<br>Clonazepam<br>Clorazepate<br>Diazepam<br>Midazolam<br>Lorazepam |
| bromides | Potassium bromide |
| carbamates | Felbamate |
| carboxamides | Carbamazepine<br>oxcarbazepine |
| Fatty acids | Valproates, such as valproic acid, sodium valproate, and divalproex sodium<br>Vigabatrin<br>Progabide |

| Class of anti-epileptic compound | Examples |
|---|---|
| | tiagabine |
| Fructose derivatives | topiramate |
| GABA analogs | Gabapentin<br>pregabalin |
| hydantoins | Ethotoin<br>Phenytoin<br>Mephenytoin<br>fosphenytoin |
| oxazolidinediones | Paramethadione<br>Trimethadione<br>ethadione |
| prpionates | beclamide |
| pyrimiddinediones | primidone |
| Pyrrolidines | Brivaracetam<br>Levetiracetam<br>seletracetam |
| Succinimides | Ethosuximide<br>Phensuximide<br>mesuximide |
| Sulfonamides | Acetazolamide<br>Sulthiame<br>Methazolamide<br>zonisamide |
| Triazines | lamotrigine |
| Ureas | Pheneturide<br>phenacemide |
| Valproylamides | Valpromide<br>valnoctamide |

The '091 patent does not have any teaching suggesting the selection of the "fructose derivative" class of epileptic compounds, nor the specific fructose derivative of topiramate. Thus, there is no motivation to combine the two references to obtain the claimed composition.

**2. No Substantial Likelihood of Success**

Moreover, given that the '091 patent does not provide any specific teaching regarding topiramate, and that the class of "anti-epileptic compounds" encompasses such a wide variety of subclasses and specific types of compounds, one of skill in the art would not have any reasonable expectation of success in combining the two references to obtain the claimed invention.

For at least these reasons, the provisional nonstatutory obviousness-type double patenting rejection is improper. Reconsideration and withdrawal of this ground of rejection is therefore respectfully requested.

*(b) U.S. Appl. No. 10/619,539*

The Examiner provisionally rejected claims 1-17, 24-27, 29-33, 35, 36, 39-46, 49-56, 58, 65, 77-90 and 92 on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1, 10, 11, 14, 16, 17, 19, 21-26, 28, 29, 32-38, 41, 46-50, 59, 60, 62, 63, 65, 67-70, 76, 77, 89, 90, 93, 95, 96, 98, 100-104 and 107 of co-pending U.S. Appl. No. 10/619,539.

Co-pending U.S. Appl. No. 10/619,539, like the '091 patent discussed above, does not teach or suggest the use of topiramate in nanoparticulate active agent compositions. Rather, like the '091 patent, U.S. Appl. No. 10/619,539 refers to the use of "antiepileptics" in nanoparticulate active agent compositions. For the same reasons detailed above with respect to the '091 patent, this disclosure does not teach or suggest the claimed invention. For at least these reasons, withdrawal of this ground for rejection is respectfully requested.

## VI. The Rejection Under 35 U.S.C. § 103(a)

*(a) U.S. Patent No. 6,592,903*

The Examiner rejected claims 1, 2, 4, 6-8, 10 and 11 under 35 U.S.C. § 103(a) for allegedly being obvious over U.S. Pat. No. 6,592,903. Applicants respectfully traverse this rejection.

As noted by the Examiner, U.S. Pat. No. 6,592, 903, is available as prior art, if at all, solely under 35 U.S.C. § 102(e). In fact, this reference does not preclude patentability of the present claims because it was owned by the same entity or was under an obligation of assignment to the same entity when the claimed invention was made. *See* 35 USC § 103(c).

Applicants make the following statement in accordance with MPEP § 706.02(l)(2):

> At the time that the presently claimed invention was made, the present application and U.S. Patent No. 6,592, 903 were owned by or were subject to an obligation of assignment to Elan Pharma International Ltd.

Because § 103(c) precludes U.S. Pat. No. 6,592,903 from defeating patentability of the present claims, Applicants respectfully request withdrawal of this obviousness rejection.

*(b) U.S. Appl. No. 10/619,539*

The Examiner provisionally rejected claims 1-17, 24-27, 29-33, 35, 36, 39-46, 49-56, 58, 65, 77-90 and 92 under 35 U.S.C. § 103(a) for allegedly being obvious over co-pending U.S. Patent Application No. 10/619,539. Applicants respectfully traverse this provisional rejection.

Co-pending U.S. Pat. Appl. No. 10/619,539 was published on 23 Dec. 2004, which is less than one year after the 30 Jan. 2004 filing date of the present application; hence, it qualifies as prior art, if at all, solely under 35 U.S.C. § 102(e), and not under "another subsection of 35 U.S.C. 102" as alleged, but not identified, in the Office Action at paragraph 9, page 7. In fact, this reference does not preclude patentability of the present claims because it was owned by the same entity or was under an obligation of assignment to the same entity when the claimed invention was made. *See* 35 USC § 103(c).

In this regard, Applicants make the following statement in accordance with MPEP § 706.02(l)(2):

> At the time that the presently claimed invention was made, the present application and co-pending U.S. Patent Application No. 10/619,539 were owned by or were subject to an obligation of assignment to Elan Pharma International Ltd.

Because § 103(c) precludes U.S. Pat. Appl. No. 10/619,539 from defeating patentability of the present claims, Applicants respectfully request withdrawal of this provisional obviousness rejection.

## CONCLUSION

All of the stated grounds of objections and rejections have been properly traversed or rendered moot. Therefore, the present application is now in condition for allowance, and an early notice to that effect is earnestly solicited.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date January 17, 2007 By Victoria S Rutherford

FOLEY & LARDNER LLP
Customer Number: 31049
Telephone: (202) 672-5538
Facsimile: (202) 672-5399

Michele M. Simkin
Attorney for Applicant
Registration No. 34,717

Victoria S. Rutherford
Agent for Applicant
Registration No. 52,253